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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,794	11/13/2001	Stanley Stewart Collins	43992/241147	5851

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EXAMINER

TORRES, ALICIA M

ART UNIT	PAPER NUMBER
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3671

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/010,794

Applicant(s)

COLLINS ET AL. *SW*

Examiner

Alicia M Torres

Art Unit

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8, 9, 11-13 and 18-20 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5 and 21 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

Art Unit: 3671

Response to Arguments

1. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

DETAILED ACTION

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Armstrong et al., hereafter Armstrong.

Steinbock discloses a trench-digging machine for digging a trench under a structure comprising:

A frame (1-4) for operable connection to a transport machine (not shown), wherein the frame (1-4) comprises a pair of widthwise extending rails (3, 3') and at least one strut (1) extending between the pair of rails (3, 3') and the transport machine defines a lengthwise extending axis and extends widthwise between a pair of lateral bounding planes; and

A digging implement (unnumbered) connected to the frame (1-4) for digging the trench,

Wherein the frame (1-4) is connected to the transport machine such that a center-line of the digging implement is capable of being laterally offset from the lengthwise extending axis to a

Art Unit: 3671

position beyond the respective lateral bounding planes, thereby permitting the digging implement to be placed under the structure.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaczmariski et al., hereafter Kaczmariski, in view of Armstrong et al., hereafter Armstrong.

Kaczmariski discloses a trench-digging machine for digging a trench under a structure comprising:

A frame (12) for operable connection to a transport machine (14), wherein the transport machine (14) defines a lengthwise extending axis and extends widthwise between a pair of lateral bounding planes (defined by the sides of transport machine 14);

A digging implement (10) connected to the frame (12) for digging the trench, wherein the frame (12) is connected to the transport machine (14) such that a center-line of the digging implement (10) is capable of being laterally offset from the lengthwise extending axis to a position beyond the respective lateral bounding planes (see figure 5), thereby permitting the digging implement (10) to be placed under the structure, as per claim 1; and

Wherein the attachment plate (52) is capable of connecting the frame (12) to the transport machine (14) at a plurality of predetermined positions such that the center-line of the digging

Art Unit: 3671

Implement (10) carried by the frame (12) is adjustable with respect to the lengthwise extending axis of the transport machine (14) by connecting the frame (12) to the transport machine (14) at different predetermined positions, as per claim 2.

However, Kaczmarski fails to disclose an attachment plate carried by the transport machine and capable of connecting the frame to the transport machine wherein the attachment plate is oriented at a permanently fixed angle offset from vertical such that the attachment plate faces downwardly at a fixed position.

Armstrong discloses an attachment plate (118) carried by the transport machine (10) and capable of connecting the frame (100) to the transport machine (10) wherein the attachment plate (118) is oriented at a permanently fixed angle offset from vertical such that the attachment plate (118) faces downwardly at a fixed position.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the downwardly facing plate of Armstrong on the trench-digging machine of Kaczmarski in order to allow for movement of the trencher between a plurality of positions.

6. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steinbock in view of Armstrong.

In regards to claims 4 and 5, Steinbock discloses a trench-digging machine for digging a trench under a structure comprising:

Art Unit: 3671

A frame (1-4) for operable connection to a transport machine (not shown), wherein the transport machine defines a lengthwise extending axis and extends widthwise between a pair of lateral bounding planes;

A digging implement (unnumbered) connected to the frame (1-4) for digging the trench, wherein the frame (1-4) is connected to the transport machine such that a center-line of the digging implement is capable of being laterally offset from the lengthwise extending axis to a position beyond the respective lateral bounding planes, thereby permitting the digging implement to be placed under the structure; and

wherein the frame (1-4) comprises a pair of widthwise extending rails (3, 3') and at least one strut (1) extending between the pair of rails (3, 3'), as per claim 4.

However, Steinbock fails to disclose an attachment plate carried by the transport machine and capable of connecting the frame to the transport machine at a plurality of predetermined positions such that the center-line of the digging implement carried by the frame is adjustable with respect to the lengthwise extending axis of the transport machine by connecting the frame to the transport machine at different predetermined positions, wherein the attachment plate is oriented at an angle offset from vertical such that the attachment plate faces downwardly and wherein the attachment plate is connected to the at least one strut of the frame, as per claim 4; and

Wherein the at least one strut of the frame also extends at substantially the same angle offset from vertical as the attachment plate, as per claim 5.

Armstrong discloses an attachment plate (118) carried by the transport machine (10) and capable of connecting the frame of Steinbock to the transport machine (10) at a plurality of

Art Unit: 3671

predetermined positions such that the center-line of the digging implement carried by the frame is adjustable with respect to the lengthwise extending axis of the transport machine (10) by connecting the frame to the transport machine (10) at different predetermined positions, wherein the attachment plate (118) is oriented at an angle offset from vertical such that the attachment plate faces downwardly and wherein the attachment plate is connected to the at least one strut of the frame, as per claim 4; and

Wherein the at least one strut of the frame will extend at substantially the same angle offset from vertical as the attachment plate when mounted, as per claim 5.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the attachment plate of Armstrong on the implement of Steinbock in order to provide a one of a plurality of connecting means.

Allowable Subject Matter

7. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 8, 9, 11-13, and 18-20 are allowed.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

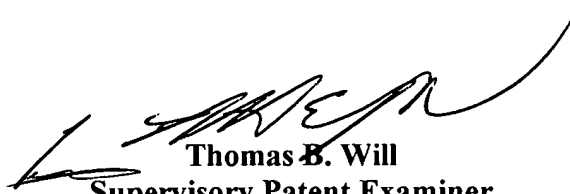
Art Unit: 3671

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia M. Torres whose telephone number is 703-305-6953. The examiner can normally be reached Monday through Thursday from 7:00 a.m. – 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached at 703-308-3870.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is 703-305-1113. The fax number for this Group is 703-872-9306.


Thomas B. Will
Supervisory Patent Examiner
Group Art Unit 3671

AMT
November 14, 2003